FORM PTO-1083

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PATENT

Attorney Docket No. 218138
DHHS Ref. E-259-2000/0-US-02
Date: March 6, 2003

In re Application of: Stratakis et al.
Application No: 09/935,916
Filed: August 23, 2001
For: PROTEIN KINASE A AND CARNEY COMPLEX

MAR 1 2 2003

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

Transmitted herewith is a Response To Restriction Requirement in the subject application.

☐ Applicants claim small entity status of this application under 37 CFR 1.27.

☒ Petition for Extension of Time
- ☒ Applicants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is $110.00 (enclosed).
- ☐ Applicants believe that no petition for an extension of time is necessary. However, to the extent that such petition is deemed necessary, Applicants hereby petition for a sufficient extension of time to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.

☒ No additional claim fee is required.
☐ Other:

The claim fee has been calculated as shown below:

					Small Entity		Other Than A Small Entity	
	Claims Remaining After Amendment		Highest Number Previously Paid For	Extra Claims Present	Rate	Addit. Claim Fee	Rate	Addit. Claim Fee
Total		Minus		=0	x 9=	$	x 18=	$0
Independent		Minus		=0	x 42=	$	x 84=	$0
☐ First Presentation of Multiple Claim					+ 140=	$	+ 280=	$
					Total	$	Total	$0

☒ Please charge my Deposit Account No. 12-1216 in the amount of $110.00. A duplicate copy of this sheet is attached.

☒ The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216. A duplicate copy of this sheet is attached.
- ☒ Any filing fees under 37 CFR 1.16 for the presentation of extra claims.

☒ Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

LEYDIG, VOIT & MAYER, LTD.

By _____
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CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: March 6, 2003 Kathleen M. Grant

PATENT
Attorney Docket No. 218138
DHHS Ref. No. E-259-2000/0-US-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Stratakis et al.

Application No. 09/935,916

Filed: August 23, 2001

For: PROTEIN KINASE A AND CARNEY COMPLEX

Group Art Unit: 1614

Examiner: J. N. Fredman

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated January 8, 2003, please consider the following remarks.

REMARKS

Restriction Requirement

The Office has set forth a restriction requirement. In particular, the Office requires Applicants to elect one of the following groups:

(I) claims 1 and 3, drawn to nucleic acid sequences (class 536, subclass 23.1),

(II) claim 2, drawn to amino acid sequences (class 530, subclass 350),

(III) claims 4-30, drawn to nucleic acid detection methods (class 435, subclass 6),

(IV) claims 31-33, drawn to antibodies (class 530, subclass 387.1), and

(V) claims 34-38, drawn to antibody detection methods (class 435, subclass 7.1).

Additionally, the Office has required that a single nucleic acid sequence or a single amino acid sequence be elected for examination.

Election in Response to Restriction Requirement

Applicants hereby elect, with traverse, the claims of Group I (i.e., claims 1 and 3). Additionally, as required by the Office, Applicants elect, with traverse, SEQ ID NO: 41, which reads on claim 3.

Discussion of the Restriction Requirement

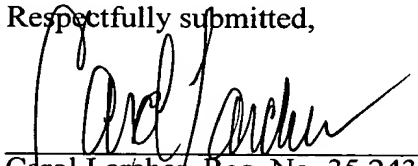
There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, "[i]If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

In the case at hand, the Office has failed to meet the two criteria for a proper restriction requirement by failing to show that there would be a serious burden on the Examiner if the restriction were not required. There is significant overlap in subject matter between the groups of claims. All of the nucleic acid sequences and corresponding amino acid sequences and antibodies thereto relate to the protein kinase regulatory subunit 1A gene, such that references considered during the examination of the claims of one group would be considered during the examination of the claims of another group. In this regard, Applicants point out that the claims of Groups II and IV are classified in the same class, as are the claims of Groups III and V. This is not to say that the claims stand or fall together. Rather, the overlap in the relevance of references and the overlap in the classification of the claimed subject matter mitigates against the necessity for a restriction requirement.

At the very least, all of the nucleic acid sequences of Group I (i.e., claims 1 and 3) should be examined together. All of these nucleic acid sequences have been classified in the same class and subclass, and are contained within the protein kinase regulatory subunit 1A gene. As such, a search performed by the Office with respect to one sequence from Group I would likely uncover references that would be considered by the Office with respect to the remaining sequences of Group I.

Therefore, Applicants submit that the requirement for restriction is not proper. Accordingly, Applicants request the withdrawal of the requirement for restriction and examination of all of the pending claims, or at the very least, the examination of all of the nucleic acid sequences of Group I (i.e., claims 1 and 3).

Respectfully submitted,



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Dated: March 6, 2003